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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,321	04/02/2001	Vito A. Coppola	P04988US1	1241 9
22885	7590	06/18/2003	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			IP, SIKYIN	
		ART UNIT	PAPER NUMBER	
		1742		

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N	Applicant(s)
	09/824,321	COPPOLA, VITO A.
	Examiner	Art Unit
	Sikyin Ip	1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 22-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 22-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
4. Claims 22-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/047,709 (see U.S. Pub. No. :US 2002/0056191).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compositions and method steps are overlapped by claims of said copending application. An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in

structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Moreover, overlapping ranges have been held to be a *prima facie* case of obviousness. See In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 22-27 and 32-37 are rejected under 35 U.S.C. § 103 as being unpatentable

over JP 04041676 (PTO-1449, abstract).

9. Claims 22-37 are rejected under 35 U.S.C. § 103 as being unpatentable over GB 2242203.

10. The cited JP 04041676 reference(s) disclose(s) the features including the claimed Ni-Pt oxidation resistance alloy and step of heat said alloy at least 500 °C in an inert atmosphere containing reducing gas (see abstract). GB 2242203 in page 6, lines 22-23 teaches to use Pt greater than 5 wt.% and heat said alloy to temperature no significantly above 1000°C (page 8, lines 17-20). But “greater than 5 wt.% reads on the claimed “5 wt.%”. The difference between the reference(s) and the claims are as follows: JP 04041676 and GB 2242203 do not disclose using Ni powder as starting material and heating the Ni-Pt alloy in N-1%H₂ atmosphere, and the product having oxidation resistance property above 500°C. The claimed articles have no structure which reads on the articles of cited references. With respect to use Ni powder as starting material that it is well settled that the form of reactants is believed mere a choice between well known forms of such substances. In the absence of evidence of some unobvious aspect of their selection, use of those substances would seem to add nothing of patentable significance to the instant claims. In re Austin, et al., 149 USPQ 685, 688. Furthermore, the invention defined in a product-by-process claim is a product, not a process. In re Bridgeford, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966) and MPEP § 2113. It is the patentability of the product claimed and not of the recited process steps which must be established. See In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972). The guidance that has been provided by court on this matter is

[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964, 966 (Fed. Cir. 1985). When applicant's and prior art's products are to be identical or substantially identical, the burden shifts to applicant to provide evidence that the prior art product does not inherently possess the claimed properties. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745 180 USPQ 324, 326 (CCPA 1974); and *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

11. As is evinced by GB 2242203 which in page 8, lines 5-14 discloses Ni-Pt alloy could be heated at temperature range of 600 to 1000°C under reducing gas (such as hydrogen) and diluted with an inert gas such as nitrogen to prevent air or oxygen. With respect to instant claim 30, GB 2242203 in page 8, lines 14-17 teaches that time and temperature profiles could be altered in order to achieve particular alloy characteristics. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to heat treat Ni-Pt alloy in reducing gas atmosphere such as nitrogen-hydrogen atmosphere in order to prevent oxidation during the heat treat process and varying the heat treatment time in order to achieve particular alloy characteristics as taught by GB 2242203.

In re Venner, 120 USPQ 193 (CCPA 1958), *In re LaVerne, et al.*, 108 USPQ 335, and *In re Aller, et al.*, 105 USPQ 233.

12. With respect to the claimed oxidation resistance property above 500°C that cited JP 04041676 discloses their Ni-Pt alloy is oxidation resistance. Therefore, it meets applicant's

limitation. However, the instant claimed Ni-Pt composition, heat treatment step, and heat treatment gas atmosphere are overlapped by the cited references; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. *In re Spade*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) and *In re Best*, 195 USPQ 430 and MPEP § 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).”

Response to Arguments

13. Applicant's arguments filed March 25, 2003 have been fully considered but they are not persuasive.

14. Applicant argues that the recited transitional expression “consisting essentially of” excludes the preliminary heat treatment step required by JP '676. But, it is well settled that the recitation of “consisting essentially of” limits the scope of a claim to the specified ingredients (here steps) and those that do not materially affect the basic and novel characteristics of a composition. *Ex parte Davis, et al.*, 80 USPQ 448, 450 (PTO Bd. App.

1948), In re Janakirama-Rao, 317 F. 2d 951, 137 USPQ 893, 894 (CCPA 1963), In re Garnero, 412 F 2d 276, 162 USPQ 221, 223 (CCPA 1969), and In re Herz, et al., 190 USPQ 461, 463 (CCPA 1976). When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of" applicant has the burden of showing the basic and novel characteristic of his/her composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition. In re De Lajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and Ex parte Davis, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948).

15. Applicant argues that the cited references do not use Ni powder as starting material. But, it is well settled that the form of reactants is believed mere a choice between well known forms of such substances. In the absence of evidence of some unobvious aspect of their selection, use of those substances would seem to add nothing of patentable significance to the instant claims. In re Austin, et al., 149 USPQ 685, 688.

16. Applicant's argument as set forth in paragraph bridging pages 7-8 and first full paragraph in page 9 of the instant remarks is noted. But, applicant has not substantiated his position with factual evidence in declaration.

17. Applicant argues that alloy of JP04041676 contains 10 wt.% Pt. But, applicant's attention is directed to the abstract which discloses noble metals such as Pt is 5 to 30 % of the amount of the metal resinate.

18. Applicant argues that GB 2242203 fails to teach reducing atmosphere. Applicant's

attention is directed to page 8, lines 10-14 which said reference teaches inert gas or reducing atmosphere could be used. Gas reducing agent such as hydrogen may be diluted with nitrogen (see page 8, lines 6-9).

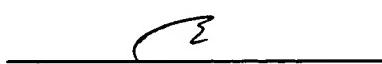
19. Applicant's argument as set forth in paragraph bridging pages 8-9 of the instant remarks is noted. But, applicant's attention is directed to page 6, lines 22-23 of said reference which discloses amount of Pt is greater than 5 wt.%. Said "greater than 5 wt.%" of Pt reads on the claimed 5 wt.% to less than 10 wt.%.

20. Applicant's argument as set forth in paragraph bridging pages 9-10 of the instant remarks is noted. But, both cited references do teach Pt less than 10 wt.% (see JP 04041676 - abstract and GB 2242203 - page 6, lines 22-25).

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.


SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
June 14, 2003